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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,729	09/28/1999	IN TAE HWANG	CIT/K-090	1898
34610	7590	07/12/2005	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			ELALLAM, AHMED	
			ART UNIT	PAPER NUMBER
			2662	
DATE MAILED: 07/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,729

Applicant(s)

HWANG ET AL.

Examiner

AHMED ELALLAM

Art Unit

2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 34-47 and 49-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 34-47 and 49-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/04 & 4/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to communication filed on January 26, 2005.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-13 and 34-47, 49-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
2. Claims 1 and 10 both recite selecting the transport format according to the decided bearer service profile type. However, the specification does not adequately describe how such a selection is made, such that a skilled artisan could make and use the claimed invention. Namely, the specification does not show any correlation between the decided bearer service profile type and how it is used to select the transport format. For example, which transport format is used when the bearer service is speech? Which transport format is selected when the bearer service is packet switched data? Claims 34 and 58 recite determining the transport format combination set according to the type of

wireless service and the radio environment measurement. However, the specification does not adequately describe how such a determination is made, such that a skilled artisan could make and use the claimed invention. Specifically, the specification does not draw any correlation between what a particular wireless service and environment measurement are and how they correspond to a determined particular transport format combination set to be used. For example, if the wireless service is speech service and the environmental measurement indicates the radio is in a vehicle, what would be the corresponding transport format combination set?

Claims 2-9, 11-13, 35-57, 59 and 60 are rejected because they depend on rejected base claims.

Response to Arguments

3. Applicant's arguments filed 1/26/2005 have been fully considered but they are not persuasive:

Applicant's argument with reference to the 112 1st rejections of pending claims 1-13, 34-47 and 49-60 is not persuasive. Applicants refer to the previously filed argument on June 17, 2004, in which Applicant relied upon "Juhua Korhonen Introduction to 3G Mobile Communications, Second Edition, pgs 397-399, Figure 3.9, page 93, Exhibit B, Exhibit C (figure 3.23), and Exhibit D. However, Examiner notes that reliance on Juha Korhonen (and not Juhua Korhonen as Applicants indicated on page 14 of June 17, 2004 response) with regard to the transport formats, bearer service profile type and the radio environment measurements in overcoming the 112 1st rejections is not given

weight because it has a publication date of 2003, while the Application claim priority back to October 1998. Therefore, given the time gap between the filing priority date by Applicants and the publication date of Juha Korhonen's book, Applicants' argument is not persuasive since the relied upon passages and Exhibits were not available, at the time of the invention so a skilled artisan could make and use the claimed invention.

Applicants' argument with reference to figure 1A, in which the Applicants assert that the *"AP decides the bearer service combination type for transferring data and RRC receives the bearer service combination type from the AP and assigns a transport format combination set (TFCS) that is best suited to handle the data to be transmitted"*, Applicants further stated that *"the transport format combination set is a set of transport format combinations to be used by a mobile station. Further, the transport format combinations include valid combinations of transport formats. A transport format may be then selected within the assigned transport format set. This is how the transport format may be selected according to the bearer service profile type."* Examiner notes that these features are rejected for the same reasons indicated above with reference to the 112 1st rejections. Applicants did not provide any evidence that was available prior to or on the filing date of the instant Application to support the argument.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Roobol et al, US (6,307,867); Widegren et al, US (6,374,112); and Forslow, US (6,608,832).

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2662

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM

Examiner

Art Unit 2662

July 8, 2005



JOHN PEZZLO
PRIMARY EXAMINER